

## **REMARKS**

### **Double Patenting Rejection**

Applicants submit that the claims of the present application, as amended, and the claims of the conflicting co-pending application, Serial No. 11/074,321, do not claim the same invention. Therefore, the double patenting rejection should be withdrawn or held in abeyance until one of the applications is allowed except for the double patenting rejection. See MPEP § 804.

### **Section 112 Rejections**

Applicants submit that the § 112, ¶ 2 rejections are moot in view of the amendments to the claims made above.

### **Section 103 Rejections**

In the Office Action, claims 1-6, 10-15 and 19 were rejected as being obvious under 35 U.S.C. § 103(a) over U.S. Patent 5,699,527 to Davidson in view of published U.S. patent application Pub. No. 2001/0011366 to Beck et al. Claims 7-9 and 16-18 were rejected as being obvious over Davidson in view of Beck, and further in view of Scott, "Is e-mortgage ready for takeoff?"

Claim 1 has been amended to clarify that the plurality of tasks that are generated comprise actions required to process the mortgage loan "so that a third party originator of the mortgage loan can be legally compensated for originating the mortgage loan." Claim 1 has also been amended to clarify that the process comprises accepting voice input transactions from the third party originator. Independent claims 10 and 19 have

been amended in a similar manner. Claims 7 and 16 have been cancelled.

One of the requirements of a *prima facie* case of obviousness under § 103 is that the cited references must teach or suggest all of the claim limitations. See MPEP 2142. Here, the cited references do not teach or suggest all of the limitations of the pending claims.

**First**, neither Davidson nor Beck discloses the step of generating tasks that comprise actions required to process the mortgage loan so that a third party originator of the mortgage loan can be legally compensated for originating the mortgage loan. In fact, neither Davidson nor Beck is directed to mortgage loans, but rather both concern commercial business loans. This is a substantive difference. The regulatory regimes for mortgage loans and commercial business loans are vastly different, including, with particular importance to the claims of the present invention, regulations that allow mortgage loan originators to receive compensation for originating a mortgage loan. See specification at pp. 3-4 (discussing RESPA).

**Second**, neither Davidson nor Beck discloses accepting voice input transactions from the third party originator pertaining to the mortgage loan. Indeed, because both Davidson and Beck do not pertain to mortgage loans, they fail to describe any steps or activities relating to third party originators of mortgage loans. They therefore necessarily fail to disclose the step of accepting voice input transactions from the third party originator pertaining to the mortgage loan.

For at least these reasons, independent claims 1, 10 and 19, as well as their respective dependent claims, are not obvious in view of Davidson and Beck.

Further, the teachings of the Scott paper cannot be used to overcome the

deficiencies of Davidson and Beck. The online mortgage consumer shopping scenario described in the Scott paper is portrayed as purely speculative and conjectural. For instance, the Scott paper describes how online mortgage consumer shopping “could be on the horizon” (see p.65) and “appears quite the long shot” (see p. 67). There is no indication of an expectation of success, which is another of the *prima facie* requirements of a case of obviousness under § 103. See MPEP § 2141.

Further, the scenario described in the Scott paper would eliminate the mortgage loan originator. See p. 65 (“Under such a business scenario, the jobs of the mortgage banker or broker, at least as defined today, may cease to exist.”); p. 69-70 (“By initiating the mortgage origination process directly with the consolidator, the consumer would trim steps and **save on loan origination fees** ...”) (emphasis added). In contrast, the process of claim 1 requires generating tasks for processing a mortgage loan so that third party originators can be compensated for originating the mortgage loan. The Scott paper teaches the exact opposite and, therefore, teaches away from the claimed invention. It teaches that loan originators will cease to exist in the future, thus eliminating the very loan origination fees that are the subject of claim 1. Thus, the Scott paper in fact teaches away from the invention of claim 1. See MPEP § 2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”) (quoting *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Therefore, the pending claims of the present application are also nonobvious in view of Davidson, Beck and Scott.

**CONCLUSION**

In view of the above, Applicants respectfully request withdrawal of the rejections and allowance of the claims. If the Examiner is of the opinion that the instant application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,

Date: May 8, 2007



---

Mark G. Knedeisen  
Reg. No. 42,747

KIRKPATRICK & LOCKHART PRESTON GATES ELLIS, LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222

Ph. (412) 355-6342  
Fax (412) 355-6501